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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,763

10/04/2006

Emile Lopez

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466 7590 05/31/2011

YOUNG & THOMPSON  
209 Madison Street  
Suite 500  
Alexandria, VA 22314

EXAMINER

JANCA, ANDREW JOSEPH

ART UNIT

PAPER NUMBER

1774

NOTIFICATION DATE

DELIVERY MODE

05/31/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,763	<b>Applicant(s)</b> LOPEZ, EMILE	
	<b>Examiner</b> ANDREW JANCA	<b>Art Unit</b> 1774	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5,7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. In view of the Pre-Brief Conference Request filed on 4/21/11, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Walter D. Griffin/  
Supervisory Patent Examiner, Art Unit 1774

### ***Response to Arguments***

2. Appellant's arguments filed 4/21/11 have been fully considered but they are not persuasive. However, as substantial 112 2nd paragraph issues were missed in the prior actions, this action is made non-final in order to address these issues.

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3. The first chamber of Birdseye has means for heating of the radiant type 16 (figure 1) which are substantially identical in structure to the disclosed means for heating of the radiant type 16 in Appellant's specification (figure 1). None of the other "means for" limitations have any further description or illustration of corresponding structure in Appellant's disclosure. However, Birdseye further discloses mechanical transfer means 20, 30 (figure 1) which are also substantially identical in structure to Appellant's disclosed mechanical transfer means 12 (figure 1). Birdseye further explicitly teaches that the infrared heating lamps are capable of heating the chambers through which the mechanical transfer means passes to temperatures ranging from 200 F to as high as 350 F, or 143 C to 226 C (8:55-61). Birdseye's apparatus may be designed to heat and dry particulate or granular vegetables or vegetable pieces, but it is equally capable of heating worn road materials which may be viscous.

4. Regarding the "claimed means for agglutinating the heated worn road coatings" (Pre-Appeal Brief p 3), as Appellant's specification provides no corresponding structure for the claimed means, the only threshold Birdseye's means must meet is being able to agglutinate sticky particles. The paired rollers 22-27 Birdseye discloses to transfer dried particulate materials from one heating chamber to another, although having a scattering effect upon the dry food particles the apparatus was designed to operate upon, would clearly mush together and hence agglutinate sticky particles into larger agglomerations (Birdseye figure 1). The particles themselves are not part of the claimed apparatus, but the material worked upon. Any structure which would perform the function as worded in the claim will satisfy the claim.

5. Birdseye's disclosed apparatus is not only structurally similar to Appellant's disclosed apparatus, but—given that it is both capable of performing the functions of the claimed apparatus, and discloses structure critical to the operation of the claimed invention but not disclosed by Appellant—it would seem to be capable of doing the job of Appellant's *claimed* apparatus as well if not better than Appellant's disclosed apparatus. It has been held that the recitation of a new intended use, for an old product, does not make a claim to that old product patentable. See *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

### ***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the 1) means for evacuating gaseous effluents from the first chamber, 2) means for evacuating gaseous effluents from the second chamber, and 3) means for agglutinating the heated worn road coatings disposed at an outlet of the first chamber must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the appellant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the appellant regards as his invention.

8. Claims 5, 7, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

9. Claim 5 recites a second chamber which is "arranged to cause the worn road coatings from said first chamber to reach a second temperature..." As the specification does not describe how and when the road coatings are transferred from the first chamber to the second chamber, it is unclear what the relationship between the first and second chambers is supposed to be (are they connected by a conveyor at the same location? Are the coatings transported from one location to another? Are the coatings taken from an output of a multi-chamber device and recycled into it?). This makes the

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scope of the claims unclear because it is not clear whether claim 5 may be satisfied by a single chamber which has been mass-produced so that more than one exists, by two distinct interoperating chambers, or by a single apparatus sub-divided into compartments which may be considered chambers through which the particles may be passed in any countable order by recycling.

10. Claim 5 recites that the first and second chambers should be provided with mechanical transfer means. It is unclear whether these means are the “conveyors or transfer screens 12” referred to in the specification, or an undescribed mechanical transfer means for transferring the coatings from one chamber to the next. Given the ambiguity in what disclosed or non-disclosed element to which this limitation is intended to refer, claim 5 is further rendered unclear because it is unclear whether this limitation invokes the provisions of 112, 6th paragraph.

11. Claim 5 further recites “means for evacuating gaseous effluents from” the first and second chambers respectively. This makes the claim unclear because while the claim appears to invoke 112, 6<sup>th</sup> paragraph, no structure is disclosed by the specification for performing the claimed function. Alternatively, if the vertical pipe element at the top of figure 1 is supposed to be the claimed means, as this is nowhere described or pointed out in the written specification the supporting disclosure fails to clearly link this possibly disclosed structure to the claimed function.

12. Claim 5 further recites “means for agglutinating the heated worn road coatings”. This makes the claim unclear because while the claim appears to invoke 112, 6<sup>th</sup>

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paragraph, no structure is disclosed by the specification for performing the claimed function.

13. Claim 7 recites “means for vibrating”. This makes the claim unclear because while the claim appears to invoke 112, 6<sup>th</sup> paragraph, the specification discloses “a suitable means for vibrating them and for example with eccentric motors” (9:3-4). As the only structure is recited as an example, it is unclear what the structural equivalent of this limitation should be.

14. Claim 9 recites “composition catalysts” while the specification (10:15) describes only “decomposition catalysts”. It is unclear whether the composition catalysts of claim 9 are supposed to be the same as the decomposition catalysts mentioned in the specification, or whether they have a different function.

15. Claim 9 recites “means for treating the gaseous effluents emitted from the second chamber including composition catalysts”. This makes the claim unclear because while the claim appears to invoke 112, 6<sup>th</sup> paragraph, no structure is disclosed by the specification for performing the claimed function.

### ***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.



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17. Claims 5, 7, and 9 are rejected under 35 USC 102(b) as anticipated by US 2,419,876 to Birdseye.

18. With regard to claim 5, Birdseye discloses a device capable of heating a material constituted at least in part by worn road coatings to be recycled, comprising a first chamber 12-20 (chambers referred to by floor and ceiling part numbers) provided with mechanical transfer means 20, means for heating 16 of the radiant type that is arranged to cause solid materials which may be worn road coatings to be recycled if desired to reach a first temperature between 105 and 130 degrees C, a temperature which would render bitumen therein viscous, and means 71 for evacuating gaseous effluents; a second chamber 29-30 provided with mechanical transfer means 30, means for heating 16 of the radiant type which are arranged to cause worn road coatings from said first chamber to reach a second temperature between 160 and 220 degrees C, and means 26-36-71 for evacuation of gaseous effluents from the second chamber; and means for agglutinating the worn road coatings to be recycled, constricted passage 22-27, disposed at the outlet of the first chamber (figure 1; 2:49-50, 6:1ff). It has been held that “[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim,” see *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969); and that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim: see *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987).

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19. The additional elements of claim 7, including that each of the first and second chambers 12-20, 29-30 comprises a substantially parallelepipedal chamber 12-20, 29-30, and that the mechanical transfer means in each of the first and second chambers comprise inclined and/or horizontal conveyors 20, 30 provided with means for vibrating 81 (raised portions under the conveyor belt will shake its contents), and that said means for heating 16 of the radiant type comprises panels 82, are taught by Birdseye (figures 1, 8-9; 9:35ff).

20. The additional elements of claim 9, including means 70-46 for treating the gaseous effluents emitted from the second chamber including composition catalysts, are taught by Birdseye (figure 1; 7:59-8:1). Composition catalysts may be introduced into the gaseous stream if desired. It has been held that “[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim.” See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

### ***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW JANCA whose telephone number is (571)270-5550. The examiner can normally be reached on M-Th 8-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on (571) 272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AJJ

/DAVID L. SORKIN/  
Primary Examiner, Art Unit 1774